

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2, 5, and 7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. According to the Supreme Court in *Bilski v. Kappos*, the subject matter must be directed to a process, machine, manufacture, or composition of matter. In order for a process claim to be statutory it must be tied to a particular machine or apparatus or particularly transform an article to a different state or thing. In the instant invention, the process claims fail to tie the article to a machine or the article does not undergo a transformation recited in process steps, and are therefore found to be non-statutory.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 – 4, 6, 7, 9 – 11, 13 and 23 - 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Browder, Jr. (US 6,276,175). The device of Browder, Jr. discloses a clothing article capable of being worn by a person having an ostomy hernia, the

clothing article is made for exerting compression (Column 3, lines 35 – 40) and is intended to be disposed around the lower portion of the body, the clothing article is characterized by knitting a seamless tubular (column 2, lines 66 - 67) which is made with an anatomic fit in a predefined size and shape and establishing a firm, elastic (Column 3, lines 26- 28) structure. The device of Browder, Jr. is made on a body size electric circular knitting machine (Column 2, lines 25 -26) and is selectively fixed on the machine form having a predetermined size and shape as the item is being constructed and is sewn together forming a panty brief with a lower body area, groin area and leg openings (Figures 1 and 2) after the garment has been fixated on a form. The extension of the garment is performed with varying intensity (Column 2, lines 30 –34) for establishing varied extension or elasticity and firmness in the article giving varied compression when the clothing article is placed on the body. Elastic yarns are formed along designated courses such that the elastic tension is even throughout the garment and the control area of the garment having spandex makes up approximately 25 – 50% of the garment (Figures 1 and 2). It is noted that the recitation "for producing compression of between 15 to 50 mmHg" is a functional recitation. The device of Browder, Jr. meets all the structural limitations claimed by applicant and is therefore interpreted to perform in the same manner as the claimed apparatus having a compression of between 15 – 50 mmHg and would have a material that displays a force/elongation curve including a largely flat curve pattern as recited by applicant.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Browder, Jr. in view of Sinigagliesi (US 2,736,036). The device of Browder, Jr. substantially discloses the claimed invention but is lacking a groin area having an aperture. The device of Sinigagliesi discloses a tubular knit garment having an aperture (13) in the groin area. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device of Browder, Jr. by utilizing the aperture taught by Sinigagliesi in order to provide access to the genitals from the exterior surface of the garment (column 2, lines 55 – 68).

5. Claims 17, 18, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Browder, Jr. The device of Browder, Jr. substantially discloses the claimed invention but is silent as to the weight per square meter of compression on the user's body. The USPTO office does not have a laboratory to perform testing, and since the device of Browder, Jr. meets all of the structural recitations as claimed by applicant, it is interpreted to perform the function of compression in the same manner as the claimed invention, at a weight per square meter of between 250 and 450g/m². The applicant does not provide criticality in the specification to the specific ranges claimed and therefore the prior art referenced meets the cited limitations.

6. Claims 15, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Browder, Jr. in view of Browder, Jr. (US, 5,572,888). The device of Browder, Jr. substantially discloses the claimed invention but is lacking elastane yarns having a thickness between 100 – 350 decitex. The device of Browder, Jr. ('888) discloses a garment having elastic yarn having a thickness of 100 to 350 decitex or 150 - 250 decitex (Column 4, line 5). It is noted that a 140 denier yarn is the equivalent to a 155.6 decitex yarn. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device of Browder, Jr. by utilizing the elastic yarns taught by Browder, Jr ('888) in order to provide the compression needed for comfort of the wearer (Column 4, lines 12 – 15).

Response to Arguments

7. Applicant's arguments filed 11/17/2009 have been fully considered but they are not persuasive.

8. Applicant submits that the device of Browder teaches away from the claimed invention since Browder discloses that the fiber composition is between 6-10% elastane fibers. Applicant's recited claim language is not claiming that the composition of the fibers is 15 – 60 % but recites that "elastane between 15 and 60% on the areas" and "wherein the fabric comprises between 15 and 60% of the elastic yarns." Applicant's claimed language only requires that the elastane yarn be located in at least 15 – 60% of the surface areas of the garment. In an interview on 11/12/2009 applicant was advised that in order to overcome the prior art the language needed to recite *fiber* content.

Specifically, that the fabric is a blended fabric having between 15-60% elastane fibers.

The device of Browder discloses elastic yarns that are evenly distributed throughout the garment and therefore interpreted to make up approximately 50%. Moreover, Browder specifically discloses elastic yarn being repeated at least every four course and therefore, elastane is present in at least 25% of the garment.

9. In response to applicant's argument that the garment of Brower does not generalize the compression to a single area, applicant has not recited that the compression only be present in a specific area of the garment structure.

10. Applicant argues that the device of Brower does not provide the claimed function of compression having the specific ranged claimed by applicant. The device of Browder, Jr. discloses all of the structural elements claimed by applicant and therefore is interpreted to perform in the same manner. Applicant argues that specific compression is not a functional recitation. The compression is a function of the elastic yarns. The elastic yarns of the claimed invention and the prior art are the same and therefore interpreted to perform in the same manner. Applicant has not recited a specific fiber weight or fabric structure which performs the claimed function. When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, the burden of proof is shifted to the applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112- 2112.02. Applicant merely asserts that the prior art does not perform the

function, but has not provided any documentation that the prior art is not capable of performing the claimed function, i.e. structural differences.

11. Applicants arguments with regard to claims 15, 16 and 20 are moot in view of new grounds of rejected stated above.

12. Applicant argues the combination of Browder and Sinigagliesi. Applicant states that the combination of references is improper because there is no suggestion or incentive to do so. Applicant argues that the device of Browder is intended for use on woman. The device of Browder is directed to an undergarment capable for use for a man or a woman. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The devices of Browder and Singigagliesi are both in the same field of endeavor, a wearing garment, and the device of Singigagliesi states that motivation for utilizing the aperture in the groin is to be able to expose the genitals (male or female) without removing the garment (column 2, lines 55 – 68).

13. With regard to claims 17, 18, 21, and 22 applicant argues that there is no suggestion of using these elements in substantially the same manner as appellants use them. The applicant claim language is not drawn to the use of the garment, nor the use

of the fabric; rather, the claims are drawn to the function of the elastic yarns and their rate of compression. As recited above, the USPTO office does not have a laboratory to perform testing to determine the function of compression for the elastic yarns disclosed in Browder, Jr., and since the device of Browder, Jr. meets all of the structural recitations as claimed by applicant, it is interpreted to perform the function of compression in the same manner as the claimed invention, at a weight per square meter of between 250 and 450g/m². It is noted that the applicant does not provide criticality in the specification to the specific ranges claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RICHALE L. QUINN whose telephone number is (571)272-8689. The examiner can normally be reached on M-F 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on 571-272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Richale L Quinn
Examiner
Art Unit 3765

/R. L. Q./
Examiner, Art Unit 3765

/KATHERINE MORAN/
Primary Examiner, Art Unit 3765